

### **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 6, 10, 11, 16 and 18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 1, the Examiner states the relationships between the large and small diameters ( $L$ ;  $S$ ) of the soft section of the first endoscope ( $L > S$ ), the diameter  $S2$  of the soft section of the second endoscope ( $S2 \geq L$ ) and the diameter  $S3$  of the soft section of the third endoscope ( $L \geq S3$ ), as set forth in claim 1: ( $S2 \geq L \geq S3$ ), and  $L > S$ .

With respect to claim 6, the Examiner states the further limitations that the small diameter of the first endoscope ( $S$ ) is equal to the diameter of the third endoscope ( $S3$ ), or ( $S = S3$ ); and that the large diameter of the first endoscope ( $L$ ) is not equal to the diameter of the second endoscope ( $S2$ ), or ( $L \neq S2$ ). The Examiner then states that claim 6 lacks the necessary limitations to maintain the scope of the application, asserting for example, that claim 6 does not prevent  $L = S$  for the first endoscope.

In response, Applicants submit that the Examiner has forgotten about the limitation of claim 1, which requires that  $L > S$ .  $L = S3$  does not violate ( $S2 \geq L \geq S3$ ), and  $L > S$ , since  $L$  can be greater than or equal to  $S3$ .

With respect to claim 7, the Examiner asserts that the claim requires  $S \geq S3$  and  $L \neq S2$ , and lacks necessary limitations to maintain the scope of the application because it does not prevent  $L = S3$ , which would present the unsupported situation that  $L = S$ .

In response, Applicants submit that the claim 1 requirements ( $S2 \geq L \geq S3$ ), and  $L > S$ , that if  $S \geq S3$ , because  $L > S$ ,  $L \geq S3$ .  $L \geq S3$  does not effect  $L \neq S2$ , and  $L > S$ .

With respect to claim 10, the Examiner asserts that the claim requires  $S=S3$  and lacks necessary limitations to maintain the scope of the application because it does not prevent  $L=S3$ , which would present the unsupported situation that  $L=S$ .

In response, Applicants submit that from the claim 1 requirement ( $S2 \geq L \geq S3$ ), and  $L > S$ , that if  $S=S3$ , then because  $L > S$ ,  $L > S3$ .  $L > S3$  does not violate claim 1.

With respect to claim 11, the Examiner asserts that the claim requires  $S \geq S3$  and lacks necessary limitations to maintain the scope of the application because it does not prevent  $L=S3$ , which would present the unsupported situation that  $L=S$ .

In response, Applicants submit that from the claim 1 requirement ( $S2 \geq L \geq S3$ ), and  $L > S$ , that  $S \geq S3$  cannot present  $L=S$  because  $S < L$ . That is, just because  $S \geq S3$  does not mean the claim 1 limitation can be ignored.

With respect to claim 16, the Examiner asserts that the claim requires  $S=S3$ ,  $L=S2$  and  $L \neq S2$  and lacks necessary limitations to maintain the scope of the application because it does not prevent  $L=S3$ , which would present the unsupported situation that  $L=S$ .

In response, claim 16 has been amended to recite:

“wherein the outer diameter of the small-diameter portion of the first endoscope is substantially equal to the outer diameter of the soft section of the third endoscope, the outer diameter of the large-diameter portion of the first endoscope is substantially equal to the outer diameter of the soft section of the second endoscope and the outer diameter of the soft section of the second endoscope is not equal to the outer diameter of the soft section of the third endoscope.”

With respect to claim 18, the Examiner asserts that the claim requires  $S=S3$  and  $L=S2$  and lacks necessary limitations to maintain the scope of the application because it does not prevent  $S3=S2$ , which would present the unsupported situation that  $L=S$ .

In response, Applicants request reconsideration of claim 18 in light of the claim 1 limitations and remarks as discussed above.

In the Official Action, the Examiner rejects claims 1, 6, 7, 10, 11, 16 and 18 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,885,208 to Moriyama (hereinafter “Moriyama”) in view of U.S. Patent no 4,690,175 to Ouchi, et al. (hereinafter “Ouchi”).

In response, Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below.

In the Official Action, the Examiner argues that “...Moriyama is silent on an endoscope with an insertion unit containing a small diameter portion and a large diameter portion as required by the first endoscope in claim 1. ...Ouchi specifically teaches the use of a small diameter (A) and a large diameter (B) in order to vary the flexibility ... It would have been obvious to one of ordinary skill in the art to provide ... of Moriyama in order to provide an endoscope ... as taught by Ouchi...”, “... Moriyama teaches...endoscopes... These endoscopes satisfy the requirements for the second and third endoscope in claim 1.” Consequently, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to have the relations of diameters of the first - third endoscopes by combining Moriyama and Ouchi.

Further, the Examiner argues, “Though Moriyama and Ouchi are silent on a large-diameter portion being substantially equal to or smaller than the outer diameter of the soft section of a second endoscope ( $L \leq S2$ ) and a large-diameter portion being substantially equal to or larger than the outer diameter of the soft section of a third endoscope ( $S3 \leq L$ ), endoscopes by their very nature have a minimum and a maximum diameter in order to

facilitate insertion into the body cavity. It would have been obvious to one of ordinary skill in the art ... to provide endoscopes with a diameter near the maximum diameter, the minimum diameter and....”

The Applicants disagree with the Examiner’s assertions, particularly with the Examiner’s assertion that by their very nature, Endoscopes have a minimum and maximum diameter.

Firstly, Applicants would like to emphasize that the claimed endoscope system is characterized not in differentiating the diameters of the endoscope tubes, but rather in uniting the diameters so as to eliminate a sense of uncomfortableness (See page 20, lines 1-7 of the specification: “According to the present embodiment, the outer diameter of the large-diameter portion 10b of the first endoscope 1A ranges from the largest outer diameter of the soft sections 45 and 46 of the second and third endoscopes 1B and 1C to the smallest outer diameter thereof. An operator will hardly feel that something is uncomfortable when handling the first endoscope 1A.”).

Hence, how to set the outer diameter L of the large-diameter portion of the first endoscope with respect to the outer diameter S2 of the soft section of the second endoscope and the outer diameter S3 of the soft section of the third endoscope is very important in operating the first endoscope without a sense of uncomfortableness. Such structure and objective are not disclosed or contemplated by the prior art, including Moriyama nor Ouchi.

Thus, the Examiner is respectfully requested to consider the importance in setting the outer diameter L of the first endoscope in relation to the outer diameters S2 and S3 of the second and third endoscopes (see the description on page 20 lines 1-12 in the specification) and respectfully submit that neither Moriyama nor Ouchi disclose or suggest

such features, not do they or any other prior art contemplate the advantages resulting therefrom.

With regard to the rejection of claims 1, 6, 7, 10, 11, 16 and 18 under 35 U.S.C. § 103(a), independent claim 1 is not rendered obvious by the cited references because neither the Moriyama patent nor the Ouchi patent, whether taken alone or in combination, teach or suggest an Endoscope system having the features discussed above and recited in independent claim 1. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 6, 7, 10, 11, 16 and 18, being dependent upon claim 1, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 6, 7, 10, 11, 16 and 18 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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